



GOBIERNO DE PUERTO RICO
DEPARTAMENTO DE ESTADO



July 12, 2022

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SUBJECT MATTER
MARK

Office Action

POCO

CLASS
FILING NUMBER
FILING DATE
APPLICANT

007
245022-07-0
August 23, 2021
Xiaomi Inc.

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- | | |
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| <u> x </u> | 1. State clearly the goods or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services. |
| <u> </u> | 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico. |
| <u> </u> | 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico. |
| <u> </u> | 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application. |
| <u> </u> | 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation. |
| <u> </u> | 6. Others. |
| <u> </u> | 1. The registration for the applied mark is refused on the following grounds: |

SECOND OFFICE ACTION

The P.R. Trademark Office (the "P.R.TO") takes notice of your answer to our Office Action filed July 8, 2022. However, to proceed with the examination of the mark, the P.R.TO requires the Applicant to amend the application as follows:

Description of Goods is Overly Broad:

Rule 20 of the Trademark Registry Procedure Code of the Department of State for The Commonwealth of Puerto Rico (hereinafter, the Rules) provides that applications for registration of trademarks must include a list of the goods or services in relation to which a Trademark registration is desired.

An application of a mark must specify the goods or services on or in connection with which the Applicant uses, the mark in commerce. The identification should set forth common names, using terminology that is generally understood. The identification of goods or services must be specific, definite, clear, accurate, and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*,¹ USPQ2d 1296 (TTAB 1986), reversed on other grounds, 824 F.2d 957 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), modified without opinion, 498 F.2d 1406 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

The wording: "Agricultural machines, namely, cultivators, harvestors, disk harrows and seeders; aerating pumps for aquaria; mechanized livestock feeders; incubators for eggs; milking machines; hair clipping machines for animals; salt machine, namely, electric salt mills and electric salt grinder; woodworking machines, namely, woodworking saw-tooth setting machines, laser engraving machines for woodworking, circular saws for woodworking and sanding machines for woodworking; saws machines; papermaking machines; paper diaper producing equipment, namely, machines for manufacturing paper diapers; printing machines; chemical fiber spinning machines; dyeing machines, namely, dip-dyeing machines, machines for dyeing textiles; tea manufacturing machines, namely, tea processing machines, tea leaves sorting machines and machines for harvesting tea leaves; mixing machines; milling machines; mixers, namely, electric mixers; bread cutting machines; kneading machines for industrial purposes; sausage making machines; multi-purpose, electric countertop food preparation apparatus, namely, a combination meat tenderizer and marinator, for household use; food peeling machines for commercial use; beverage preparation machines, electromechanical; cigarette making machines; leather-working machines; sewing machines; ironing machines, namely, electric clothing pressing machines; bicycle assembling machines; power-operated potters' wheels; engraving machines; industrial inkjet printing machines; machines for battery industry, namely, packaging machines for batteries; cord making machines; enamel making machinery; light bulb making machines; packaging machines; briquet making machines; dishwashers; electric food blenders for household purposes; juice extractors, electric; coffee grinders, other than hand-operated; dish washing machines for household purposes; can openers, electric; kitchen grinders, electric; electrically-powered kitchen appliance for dicing, mincing, slicing and chopping food; kitchen machines, electric, for making whipped cream; food processors, electric; laundry washing machines; dry-cleaning machines; disintegrators for chemical processing; embossing machines; glass-working machines; fertilizer manufacturing equipment, namely, machines for manufacturing fertilizer; electromechanical machines for chemical industry, namely, electromechanical marking machines, grinding mills for chemical processing, emulsifying machines for chemical processing; rinsing machines, namely, clothes washing machine featuring a spray rinse system; extractors for mines; cutters being machines, namely, electric plasma cutters; drilling rigs, floating or non-floating; hydraulic excavators; elevating

apparatus, namely, elevators; elevators [lifts]; pneumatic jacks; metalworking machines, namely, machining centers; electric hammers; foundry machines in the nature of casting machines; steam engines, not for land vehicles; electronic igniting devices for internal combustion engines, namely, distributors, igniters and ignition coils; automobile motor spark plug; automobile motor igniting coil; wind turbines; paper clip making machines; zipper making machines; industrial robots; tools being parts of machines; electric wire and cable manufacturing machines; screwdrivers, electric; hand-held tools, other than hand-operated, namely, hand-held battery actuated hydraulic crimp tool; electric hand-held drill; IC handlers, namely, machines for processing integrated circuits; memory chip manufacturing machines; static electricity eliminators; optical cold working machines, namely, machines for the production of optical lenses; gas separating installations, namely, separating machines for chemical processing; painting machines; dynamos; filters for cleaning cooling air, for engines; engines, other than for land vehicles; automobile motor cooling radiator; automobile motor cooling radiator pipe; automobile motor cooling radiator lid; automobile motor cooling fan; cover of fan for cooling the automobile motor, namely, automobile engine fan covers; automobile motor cooling fan clutch; automobile motor exhausting and decontaminating device in the nature of catalytic converters; automobile motor waste gas recycle system comprising primarily compressors for recovering and recycling refrigerant gases; automobile motor muffler, namely, mufflers for automobile engines; parts for compressed-air tools, namely, pipes; automobile motor piston; engine cylinders for automobiles; engine air filters for cars; automotive engine blocks; automobile oil pump; automobile water pump; pumps for machines; valves being parts of machines; aerocondensers in the nature of air condensers; compressed air machines; air suction machines; cylinders for machines; axles for machines; door openers, electric; window closers, electric; bearings as parts of machines; automobile motor flywheel; crank shafts for automobile motor; belts for machines; electric arc welding apparatus; machines and apparatus for cleaning, electric, namely, electric window cleaning machines, electrical ultrasonic cleaning units for eyeglasses, car washing installations and machines for cleaning surfaces using high pressure water; electric cordless sweepers; multi-purpose steam cleaners; steam mops; brushes for vacuum cleaners; suction nozzles for vacuum cleaners; dust filters and bags for vacuum cleaners; fitted covers for vacuum cleaners; water tank for vacuum cleaners; floor mopping and sweeping robots for personal use; washing apparatus, namely, washing machines for household purposes; vacuum cleaners; crushing machines for industrial purposes; filtering machines for chemical processing; curtain drawing devices; electrically operated; drums being parts of machines; 3D printers; shoe polishers, electric; racket stringing machines; vending machines; electronic label printing machines for commercial use; robotic exoskeleton suits being machines; electroplating machines." under International Class 007, contains language that isn't specific enough therefore, resulting in a broad description of the products.

The Registry has discretion to require the degree of specificity necessary to identify the goods or services in relation to which the mark is used in the commerce of Puerto Rico.

The applicant may adopt the following recitation of goods, if accurate:

Class 007

Agricultural machines, namely, cultivators, harvestors, disk harrows and seeders; aerating pumps for aquaria; mechanized livestock feeders; incubators for eggs; milking machines; hair clipping machines for animals; salt machine, namely, electric salt mills and electric salt grinder; woodworking machines, namely, woodworking saw-tooth

setting machines, laser engraving machines for woodworking, circular saws for woodworking and sanding machines for woodworking; saws machines; papermaking machines; paper diaper producing equipment, namely, machines for manufacturing paper diapers; printing machines; chemical fiber spinning machines; dyeing machines, namely, dip-dyeing machines, machines for dyeing textiles; tea manufacturing machines, namely, tea processing machines, tea leaves sorting machines and machines for harvesting tea leaves; mixing machines; milling machines; mixers, namely, electric mixers; bread cutting machines; kneading machines for industrial purposes; sausage making machines; multi-purpose, electric countertop food preparation apparatus, namely, a combination meat tenderizer and marinator, for household use; food peeling machines for commercial use; beverage preparation machines, electromechanical; cigarette making machines; leather-working machines; sewing machines; ironing machines, namely, electric clothing pressing machines; bicycle assembling machines; power-operated potters' wheels; engraving machines; industrial inkjet printing machines; machines for battery industry, namely, packaging machines for batteries; cord making machines; enamel making machinery; light bulb making machines; packaging machines; briquet making machines; dishwashers; electric food blenders for household purposes; juice extractors, electric; coffee grinders, other than hand-operated; dish washing machines for household purposes; can openers, electric; kitchen grinders, electric; electrically-powered kitchen appliance for dicing, mincing, slicing and chopping food; kitchen machines, electric, for making whipped cream; food processors, electric; laundry washing machines; dry-cleaning machines; disintegrators for chemical processing; embossing machines; glass-working machines; fertilizer manufacturing equipment, namely, machines for manufacturing fertilizer; electromechanical machines for chemical industry, namely, electromechanical marking machines, grinding mills for chemical processing, emulsifying machines for chemical processing; rinsing machines, namely, clothes washing machine featuring a spray rinse system; extractors for mines; cutters being machines, namely, electric plasma cutters; drilling rigs, floating or non-floating; hydraulic excavators; elevating apparatus, namely, elevators; elevators [lifts]; pneumatic jacks; metalworking machines, namely, machining centers; electric hammers; foundry machines in the nature of casting machines; steam engines, not for land vehicles; electronic igniting devices for internal combustion engines, namely, distributors, igniters and ignition coils; automobile motor spark plug; automobile motor igniting coil; wind turbines; paper clip making machines; zipper making machines; industrial robots; tools being parts of machines, **namely, {list "tools" by their common commercial name, e.g., powered machines for cutting or shaping or finishing metals or other materials}**; electric wire and cable manufacturing machines; screwdrivers, electric; hand-held tools, other than hand-operated, namely, hand-held battery actuated hydraulic crimp tool; electric hand-held drill; IC handlers, namely, machines for processing integrated circuits; memory chip manufacturing machines; static electricity eliminators; optical cold working machines, namely, machines for the production of optical lenses; gas separating installations, namely, separating machines for chemical processing; painting machines; dynamos; filters for cleaning cooling air, for engines; engines, other than for land vehicles; automobile motor cooling radiator; automobile motor cooling radiator pipe; automobile motor cooling radiator lid; automobile motor cooling fan; cover of fan for cooling the automobile motor, namely, automobile engine fan covers; automobile motor cooling fan clutch; automobile motor exhausting and decontaminating device in the nature of catalytic converters; automobile motor waste gas recycle system comprising

primarily compressors for recovering and recycling refrigerant gases; automobile motor muffler, namely, mufflers for automobile engines; parts for compressed-air tools, namely, pipes; automobile motor piston; engine cylinders for automobiles; engine air filters for cars; automotive engine blocks; automobile oil pump; automobile water pump; pumps for machines; valves being parts of machines; aerocondensers in the nature of air condensers; compressed air machines; air suction machines; cylinders for machines; axles for machines; door openers, electric; window closers, electric; bearings as parts of machines; automobile motor flywheel; crank shafts for automobile motor; belts for machines; electric arc welding apparatus; machines and apparatus for cleaning, electric, namely, electric window cleaning machines, electrical ultrasonic cleaning units for eyeglasses, car washing installations and machines for cleaning surfaces using high pressure water; electric cordless sweepers; multi-purpose steam cleaners; steam mops; brushes for vacuum cleaners; suction nozzles for vacuum cleaners; dust filters and bags for vacuum cleaners; fitted covers for vacuum cleaners; water tank for vacuum cleaners; floor mopping and sweeping robots for personal use; washing apparatus, namely, washing machines for household purposes; vacuum cleaners; crushing machines for industrial purposes; filtering machines for chemical processing; curtain drawing devices; electrically operated; drums being parts of machines; 3D printers; shoe polishers, electric; racket stringing machines; vending machines; electronic label printing machines for commercial use; robotic exoskeleton suits being machines, **other than for medical purposes**; electroplating machines.

* Note that these suggestions are illustrative and not exhaustive.

Applicant is advised to examine the International Classification of Goods and Services established under the Nice Agreement, Tenth Edition, to describe the products or services that are used commercially in Puerto Rico. See <http://www.wipo.int/classifications/nice/es/>.

Note that Rule 33 of the Rules provides that the applicant may amend his application during the review of the application, when required by the Examining Attorney or other official reasons. The applicant may amend his application to clarify or limit, but not to extend the identification of goods or services. Given the above, the Examining Attorney requires that the applicant modify and amend its application for renewal as indicated in this Office Action or otherwise show cause why this amendment is not necessary.

In light of the aforementioned, the Examiner requires the Applicant to modify and/or amend the application for registration as provided herein or, otherwise, show cause why such modification is not required.

According to Rule 36 of Puerto Rico's Trademark Rules of Procedure amendments filed must be specified in a written and signed statement by the Applicant or its Representative. Neither Applicant nor its Representative shall rewrite, alter, modify, erase or include words in a pending application. However, the Puerto Rico Trademark Office (PRTTO) may amend the said application with the Applicant's consent.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTTO does not receive a response to the abovementioned remarks within ninety **(90) days**, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/> using the transaction office action response. The cost for the said filing is **\$15.00**. If you have any questions via email to jpagan@estado.pr.gov

Cordially,



Julio J. Pagán Pérez
Examining Attorney
Puerto Rico Trademark Office